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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,783	12/01/2003	David M. Kwasny	10990030-3	3846

7590 05/16/2006

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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Fort Collins, CO 80527-2400

EXAMINER

TADESSE, YEWEBDAR T

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,783

Applicant(s)

KWASNY ET AL.

Examiner

Yewebdar T. Tadesse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilson Woodruff (US 3,415,771).

As to claim 18, Wilson Woodruff discloses, in coating composition for treating image bearing transparencies, an apparatus or a machine for producing photographic-quality prints (see column 1, lines 26-28), comprising: an imager (hand tool or machines) for providing an image to a surface of a transparent carrier (see column 3, lines 15-18; column 5, lines 27-39); and an undercoat module (any suitable manner of dipping, rolling, doctoring or spraying, see column 4, lines 10-14) capable of applying an organic particle-based undercoat (see column 1, lines 12-15) to the surface of the transparent carrier, the particles being fused together to form undercoat and the undercoat of being fused to the second surface of the carrier such that at least a portion of the image is considered to be between the transparent carrier and the particle-based undercoat.

With respect to claim 20, In Wilson Woodruff (see column 5, line 59) the imager is capable of providing a reverse image (negative).

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3. Claims 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Brimer et al (US 4,853,706).

As to claims 18 and 19, Van Brimer et al discloses an apparatus for producing photographic-quality prints (see Fig 1a and column 1, lines 26-28), comprising: an inkjet imager (see Fig 1a) for providing an image to a surface of a transparent carrier (18 transparency); and an undercoat module (brush or contact applications, see column 5, lines 55-59 and column 6, lines 1-2) capable of applying an organic particle-based undercoat to the surface of the transparent carrier, the particles being fused together to form undercoat and the undercoat being fused to the second surface of the carrier such that at least a portion of the image is considered to be between the transparent carrier and the particle-based undercoat.

With respect to claim 20, In Van Brimer et al the imager is capable of providing a reverse image.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Morrison (US 2,751,294) discloses spraying or brushing a liquid composition containing particles (see column 6, lines 30-36). Omo et al (US 4,788,563) discloses an inkjet recording apparatus forming a reverse image (see claims 5 and 7).

Response to Arguments

5. Applicant's arguments filed 02/23/2006 have been fully considered but they are not persuasive. Woodruff and Van Brimer et al undercoat modules (as described above) are capable of applying an organic-particle based undercoat to the surface of the transparent carrier. The limitation "the particles being fused together to form

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undercoat and the undercoat being fused to the second surface of the carrier” is intended use of the apparatus. In applying the undercoat module using Woodruff’s and Van Brimer et al’s devices the particles are capable of being fused together to form undercoat and the undercoat is capable of being fused to the second surface of the carrier. It’s noted that means for fusing the particle-based undercoat is not the claimed feature of applicants’ invention whereas the intended use of the apparatus (the requirement that the particles and the undercoat being fused) is described in the amended claim (see claim 18).

Furthermore, a claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus shows all of the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) **Furthermore, “expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim.”** *Ex parte Thibault*, 164 USPQ 666,667 (Bd. App. 1969). Thus, the **“inclusion of material or article worked upon does not impart patentability to the claims.”** *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 (USPQ 458, 459 (CCPA 1963)).

6. The typographic error (see paragraph 4 of the non-final action mailed on 11/18/2005) has been corrected to include claims 18-20 (see paragraph 3, the 102 rejection over Van Brimer et al above) instead of claims 18 and 19.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yewebdar T. Tadesse whose telephone number is (571) 272-1238. The examiner can normally be reached on Monday-Friday 8:00 AM-4: 30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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